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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

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BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAMOTSU YAMAGAMI, YOICHIRO SAKO and MASANOBU YAMAMOTO

Appeal No. 95-2583
Application 07/689,057[1]

ON BRIEF

Before HARKCOM, Vice Chief Administrative Patent Judge, and JERRY SMITH and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 11-22. Claims 1-3 and 9 have been cancelled. Claims 4-8 and 10 stand withdrawn from consideration as being directed to nonelected inventions.

The claimed invention pertains to an optical recording medium in which main information is stored along the direction of

[1] Application for patent filed April 22, 1991.

recording tracks. Frame sync signals associated with each frame of main information are recorded by offsetting the recording track in a direction perpendicular to the track direction.

Representative claim 11 is reproduced as follows:

11. A magneto-optical recording medium for recording main information data which are organized into a sequence of a predetermined number of frames, each frame, prior to recording, having a frame sync signal located at a particular point in the frame, the optical recording medium comprising:

a recording track extending in a track direction;

a recordable region for magneto-optically recording the main information on the recording track along the track direction; and

wherein for each recorded frame of main information, frame sync signals having the same signal format as that of the frame sync signals for the main information data are previously recorded by offsetting the recording track in a direction perpendicular to the track direction.

The examiner relies on the following reference:

Rijnsburger	4,907,216	Mar. 06, 1990 (filed Dec. 09, 1987)

Claims 11-22 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Rijnsburger.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answers for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence

of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answers.

It is our view, after consideration of the record before us, that Rijnsburger neither anticipates nor renders obvious the invention as set forth in claims 11-22. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal the claims will all stand or fall together as a single group. Consistent with this indication appellants have made no separate arguments with respect to any of the claims on appeal. Accordingly, all the claims before us will stand or fall together. Note In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Accordingly, we will consider claim 11 as representative of all the claims on appeal before us.

We consider first the rejection of all the claims under 35 U.S.C. § 102 as anticipated by the disclosure of Rijnsburger. It is the examiner's position that the claimed recording medium structure is fully met by the Rijnsburger recording medium because the claimed details of the main information and the sync signal recorded on the disk are not functionally related to the

medium structure itself and thus are not entitled to patentable weight [answer, pages 4-5]. Appellants make several arguments to the effect that the examiner's position is in error.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Appellants and the examiner seem to agree that the frame sync signals as recited in claim 11 are not specifically disclosed in Rijnsburger, but the examiner dismisses any difference as a difference in information content and, therefore, not entitled to patentable weight. We do not agree.

The manner in which the sync signals of claim 11 are recited is that they are placed on the recording medium in a manner such that the recording track is offset in a direction perpendicular to the track direction. This results in a recording medium in which recording tracks have a physical or structural orientation on the medium which is different from recording media that do not have such tracks. This difference is not caused by the content of the sync track, but rather, by the

physical orientation of a sync signal having a specific size which is defined as the same size as the main information data frame sync signal. Since we find the physical orientation of the track to be a structural limitation, it was erroneous in this case for the examiner to ignore the specific claim recitation. Accordingly, we do not sustain the rejection of the claims under 35 U.S.C. § 102.

With respect to the rejection of the claims under 35 U.S.C. § 103, the examiner again notes that the information content is not entitled to patentable weight, and that it would have been obvious to include such information on the recording medium of Rijnsburger [answer, page 5]. As we noted above, the difference between claim 11 and Rijnsburger resides not in the information content per se but in the orientation of the recording track which holds this information. The examiner has not addressed the question of whether this particular orientation of recording track for holding the sync signal information of the type defined in the claims would have been obvious to one having ordinary skill in the art. Although Rijnsburger may teach an offset track for containing the sync information of a position signal on the recording medium, Rijnsburger contains no teachings regarding the manner of placing recording tracks for the sync signals of the main information. Whether it would have been obvious to the artisan to record main information sync signals in

an offset recording track is a question which has not been addressed but must be in order to find claim 11 unpatentable over the teachings of Rijnsburger.

The examiner has the initial burden of presenting a prima facie case of unpatentability. If the examiner does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. After evidence or argument is submitted by the applicant, patentability is determined on the totality of the record, by a preponderance of the evidence with due regard to the persuasiveness of the arguments. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, by improperly failing to give the appropriate patentable weight to the differences between claim 11 and the teachings of Rijnsburger, the examiner has failed in his burden of presenting a prima facie case of unpatentability. We do not hold that such a case is impossible to make, only that the examiner has not done so on the record of this appeal. Accordingly, we do not sustain the rejection of the claims under 35 U.S.C. § 103 based upon the record before us.

In summary, we have not sustained the rejection of the claims under either 35 U.S.C. § 102 or § 103. The decision of the examiner rejecting claims 11-22 is reversed.

REVERSED

GARY V. HARKCOM
Vice Chief Administrative Patent Judge)

JERRY SMITH
Administrative Patent Judge) BOARD OF PATENT APPEALS AND INTERFERENCES

MICHAEL R. FLEMING
Administrative Patent Judge)

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